



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,556	01/12/2004	Masakazu Sagawa	ASAM.0095	8215
7590 09/26/2006				
REED SMITH LLP Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042			EXAMINER SMITH, NICHOLAS A	
			ART UNIT 1742	PAPER NUMBER

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,556

Applicant(s)

SAGAWA ET AL.

Examiner

Nicholas A. Smith

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/959,953.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-10 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinard et al. (US Patent 5,837,121), Japanese Patent 408134692 (JP'692) or Japanese Patent 408134693 (JP'693).
4. In regards to claims 1-3, Kinard et al., JP'692 and JP'693 disclose a method of anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing an organic solvent having an alcoholic hydroxyl group and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (Kinard et al., col. 4, lines 30-65, example 3; JP'692, claims 1-4, paragraph [0010]; JP'693, paragraph [0001] and [0007]-[0010]). Regarding to the preamble of claim 1 of "having a second substrate with a phosphor layer formed on a surface thereof", there is no active step recited in the claim regarding the second substrate. Therefore, the preamble merely states the intended use and would not be given a patentable weight. See MPEP 2111.02.
5. In regards to claims 4-6, Kinard et al., JP'692 and JP'693 disclose a method of

Art Unit: 1742

anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing an aprotic organic solvent and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (Kinard et al., col. 4, lines 30-65, example 3; JP'692, claims 1-4, paragraph [0010]; JP'693, paragraph [0001] and [0007]-[0010]). Regarding to the preamble limitation in claim 4, the examiner's position was given in paragraph 4 above.

6. In regards to claims 7-10, Kinard et al., JP'692 and JP'693 disclose a method of anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing a mixed solvent comprising an organic solvent having an alcoholic hydroxyl group and an aprotic organic solvent and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (Kinard et al., col. 4, lines 30-65, example 3; JP'692, claims 1-4, paragraph [0010]; JP'693, paragraph [0001] and [0007]-[0010]). Regarding to the preamble limitation in claim 7, the examiner's position was given in paragraph 4 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas A. Smith whose telephone number is (571)-272-8760. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

Art Unit: 1742

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571)-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700